REMARKS

I. General

The issues outstanding in the instant application are as follows:

- Claims 1-7, 9-24, 26, and 27 are rejected under 35 U.S.C. § 102(b);
- Claims 8 and 25 are rejected under 35 U.S.C. § 103(a).

Applicant hereby transverses the outstanding rejections and requests reconsideration and withdrawal in light of the remarks contained herein. Claim 15 has been amended and claims 1-27 remain pending in the present application.

II. Amendment to Claim 15

Claim 15 previously read "a automatic level control (ACL)," therefore Applicant corrected the typographical error by amending the claim to recite "an automatic level control (ACL). Because the amendment presents no new material, applicant respectfully requests the Examiner enter amended claim 15.

III. 35 U.S.C. § 102 Rejections

Claims 1-7, 9-24, 26, and 27 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Venditti, United States Patent No. 5,248,933 (hereinafter *Venditti*).

In order for a claim to properly stand rejected under 35 U.S.C. § 102, the reference must teach every element of the claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

A. Claims 1-7 and 9-11

Claim 1 requires "[a] portable calibration unit...comprising...a processor in communication with said computer for controlling said variable signal source." The Office Action likens this processor to *Venditti*'s micro-processor 206; however, micro-processor 206

resides within the test equipment and not the portable calibration unit, as required by claim 1 As a result, *Venditti* fails to discloses each and every limitation of claim 1. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1.

Claims 2-7 and 9-11 each depend, either directly or indirectly, from claim 1, and, thus, inherit all of claim 1's limitations. Therefore, Applicant respectfully submits that claims 2-7 and 9-11 are allowable, at least by virtue of their dependence from claim 1. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-7 and 9-11.

B. Claims 12-18

Claim 12 requires "generating a test signal...responsive to a digital signal received from said PC." *Venditti* fails to disclose this limitation, and instead discloses a reference circuit 12 that generates the electrical parameter without reference to the calibration application program 16 or microprocessor 206. Column 2, lines 51-52, and Column 6, lines 1-20. In operation, the *Venditti* reference circuit simply produces the test signal which is measured by instrument 10. Column 6, lines 1-20. The microprocessor 206, within instrument 10, does not issue any digital signals that, in any way, control the generation of the test signal. Column 6, lines 1-20. Thus, *Venditti* does not teach, or even suggest, each and every limitation of claim 12. Applicant, therefore, contends that claim 12 is patentable over the 35 U.S.C. § 102(b) rejection of record.

Claims 13-18 depend directly or indirectly from claim 12, and thus inherit all the limitations of that independent claim. Therefore, Applicant respectfully submits claims 13-18 are allowable, at least for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 13-18.

C. Claims 19-27

Claim 19 requires "a processor within said calibration unit." The Office Action attempts to equate this processor with *Venditti*'s micro-processor 206; however, as noted above, micro-processor 206 resides within the test equipment and not the calibration unit, as required by claim 19. As a result, *Venditti* fails to discloses each and every limitation of

claim 19. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 19.

Claims 20 – 27 each depend, either directly or indirectly, from claim 19, and, thus, inherit all of claim 19's limitations. Therefore, Applicant respectfully submits that claims 20-27 are allowable, at least by virtue of their dependence from claim 19. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 20-27.

D. 35 U.S.C. § 103 Rejections

Dependent claims 8 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Venditti* in view of Cannon et al. United States Patent No. 4,816,767 (hereinafter C*annon*).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 8 and 25 depend from claims 1 and 19, respectively, and thus inherit all the limitations of their respective independent claims. As noted above with respect to claims 1 and 19, *Venditti* teaches that a micro-processor 206 resides within the tested equipment and not the portable calibration unit, as required by claims 1 and 19. The Examiner does not offer *Cannon* for supporting this missing limitation, nor does *Cannon* teach or even suggest such a limitation. Applicant, therefore, respectfully submits that the combination of *Venditti* and *Cannon* fails to teach all of the limitations of claims 8 and 25. Applicant further requests a withdrawal of the 35 U.S.C. § 103 rejections of the record.

IV. Conclusion

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 20-1078, under Order No. 10021227-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482712505US in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: July 29, 2005

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Respectfully submitted,

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